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EXAMINER

MORGAN, ROBERT W

ART UNIT PAPER NUMBER

3626

DATE MAILED: 03/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/801,753

Applicant(s)

PEACH, THOMAS EDWARD

Examiner

Robert W. Morgan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 16 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Notice to Applicant*

1. This communication is in response to the amendment filed 12/16/05. Claims 1-14 are presented for examination.

### *Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,526,386 to Chapman et al. in view of U. S. Patent No. 6,519,568 to Harvey et al.

As per claim 1, Chapman et al. teaches a system for inputting and collecting insurance information from a plurality of remotely connected agents, said system comprising:

--the claimed forms database, said forms database including completed insurance forms is met by database (128, Fig. 1) and database (132, Fig. 1) (see: column 3, lines 65 to column 4, lines 14); and

--the claimed network server providing access to said forms database from a plurality of remotely located terminals is met by the remote computer terminal (104, Fig. 1) at the insurance agent's location that is connected by a secure private network (106, Fig. 1) to the central computer (124, Fig. 1) in the form of a Citrix™ Winframe Enterprise Server (see: column 3, lines 56-62); and

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--the claimed formatting computer receiving individual client data and formatting forms with said received individual client information, completed forms being provided to said server is met by the remote terminal or computer workstation connected by a network to a central computer (see: column 3, lines 37-40). In addition, the remote computer terminal (104, Fig. 1) at the insurance agent's location that is connected by secure private network (106, Fig. 1) to the central computer (124, Fig. 1) in the form of a Citrix™ Winframe Enterprise Server (see: column 3, lines 56-62).

Chapman et al. fails to teach the claimed data transfer server.

Harvey et al. teaches a system and method for electronic data delivery that includes a transfer server (153, Fig. 10) used to upload/download files (see: column 20, lines 51-57).

One of ordinary skill in the art at the time the invention was made would have found it obvious to include transfer server as taught by Harvey et al. within the system and method of generating automobile insurance certificate from remote computer terminals as taught by the Chapman et al. with the motivation of providing a system that offers seamless delivery of real-time data from acquisition sites to delivery sites with an integration of all data streams (see: Harvey et al.: column 3, lines 19-22).

As per claim 2, Chapman et al. teaches the claimed remotely connected agents are connected over remotely located terminals, said remotely located terminals being connected to said remote server over a network, agents providing client information to said forms database from corresponding ones of said remotely connected terminals. This limitation is met by the remote computer terminal (104, Fig. 1) at the insurance agent's location that is connected by secure private network (106, Fig. 1) to the central computer (124, Fig. 1) in the form of a

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Citrix™ Winframe Enterprise Server (see: column 3, lines 56-62). Furthermore, at step 300 an insurance agent enters data into policy status database (128, Fig. 3) by means of software interface (126, Fig. 3) from remote terminal (104, Fig. 3).

As per claim 3, Chapman et al. teaches data relating to automobile insurance policies (reads on “completed insurance applications”) are stored in the policy status database (128, Fig. 1) (see: column 3, lines 65-67).

Chapman et al. fails to teach a data transfer server comprises a file transfer protocol (FTP) server.

Harvey et al. teaches a FTP application server (122, Fig. 9B) that sends files to an external server using FTP protocol (see: column 19, lines 29-31).

The obviousness of combining the teachings of Harvey et al. within the system as taught by Chapman et al. are discussed in the rejection of claim 1, and incorporated herein.

As per claim 4, Chapman et al. teaches data relating to automobile insurance policies (reads on “completed forms”) are stored in the policy status database (128, Fig. 1) (see: column 3, lines 65-67).

Chapman et al. fails to teach a data transfer server comprises an e-mail server and e-mailed to a registered originating agent.

Harvey et al. teaches a notification application server (123, Fig. 9B) used to send e-mail messages, with optional attachments (see: column 19, lines 31-32).

The obviousness of combining the teachings of Harvey et al. within the system as taught by Chapman et al. are discussed in the rejection of claim 1, and incorporated herein.

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As per claim 5, Harvey et al. teaches the claimed e-mail server includes a database, said database including e-mail addresses of registered insurance agents. This limitation is met by the notification application server (123, Fig. 9B) used to send e-mail messages, with optional attachments (see: column 19, lines 31-32, column 20, lines 61-64 and column 15, lines 55-62).

As per claim 6, Chapman et al. teaches a forms database further includes client and new business information. This feature is met by database (128, Fig. 1) and database (132, Fig. 1) (see: column 3, lines 65 to column 4, lines 14).

As per claim 7, Chapman et al. teaches remote computer terminals (104, Fig. 1) at the insurance agent's location that is connected by secure private network (106, Fig. 1) to the central computer (124, Fig. 1) in the form of a Citrix™ Winframe Enterprise Server (see: column 3, lines 56-62). In addition, Chapman et al. teaches data relating to automobile insurance policies are stored in the policy status database (128, Fig. 1) (see: column 3, lines 65-67).

Chapman et al. fails to teach a compression means for compressing form images for a single client into a single compressed file.

Harvey et al. teaches a data compression module for compressing data transmitted over the first, second and third communications network (see: column 7, lines 35-37). In addition, Harvey et al. teaches that the application server (127, Fig. 10) support data transfer of data from the acquisition site and client delivery sites (see: column 19, lines 46-48).

The obviousness of combining the teachings of Harvey et al. within the system as taught by Chapman et al. are discussed in the rejection of claim 1, and incorporated herein.

As per claim 8, Harvey teaches a data transfer server comprises:

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--the claimed e-mail server is met by the notification application server (123, Fig. 9B) used to send e-mail messages, with optional attachments (see: column 19, lines 31-32, column 20, lines 61-64 and column 15, lines 55-62); and

--the claimed file transfer protocol (FTP) server, compressed files below a selected size being e-mailed over said e-mail server to a registered agent, said compressed file being included with said e-mail and, compressed files exceeding said selected size being stored on said FTP server, said registered agent being notified of said stored compressed file location is met by the notification application server (123, Fig. 9B) used to send e-mail messages, with optional attachments (see: column 19, lines 31-32, column 20, lines 61-64 and column 15, lines 55-62). In addition, Harvey et al. teaches a FTP application server (122, Fig. 9B) that sends files to an external server using FTP protocol (see: column 19, lines 29-31). Furthermore, Harvey et al. teaches a data compression module for compressing data transmitted over the first, second and third communications network (see: column 7, lines 35-37).

As per claim 9, Chapman et al. teaches the claimed insurance policy forms include insurance policy application and contact forms (see: Fig. 9 and 10, especially name and address or agency or Office issuing).

As per claim 10, Chapman et al. teaches the claimed client data includes insurance policy application and contract data (see: Fig. 9 and 10, especially name and address or agency or Office issuing).

As per claims 11-14, they are rejected for the same reasons set forth in claims 1-9.

***Response to Arguments***

11. Applicant's arguments filed 12/16/05 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response 12/16/05.

(A) In the remarks, Applicants argue in substance that, (1) there is no disclosure or suggestion in Chapman that databases include completed forms; (2) there is no disclosure or suggestion in Chapman that the central computer formats forms and provides completed forms to another part of the system; (3) No motivation has been established for combining the features from Harvey and Chapman; (4) Applications for insurance in the claimed invention is different from the issued policies as taught by Chapman; (5) there is no motivation to introduce them into Chapman's system because they are inappropriate for Chapman's purpose; (6) there is no suggestion in Chapman of storing "new business information"; (7) the examiner does not teach or suggest, "image generation means...generating images of insurance policy forms" as required by claim 7; (8) there is no disclosure or suggestion in Harvey of "compressed file below a selected size being e-mailed over said e-mail server to a registered agent, said compressed file being included with said e-mail and, compressed files exceeding said selected size being stored on said FTP server" as required by claim 8; and (9) there is no disclosure or suggestion in Chapman of compressed image file of insurance policy forms being stored on said forms database and provided to said data transfer server "wherein said insurance policy forms include insurance policy application, contact forms and contract data" as required by claims 9 and 10.

(B) In response to Applicants arguments that (1) there is no disclosure or suggestion in Chapman that databases include completed forms; and (4) Applications for insurance in the



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claimed invention is different from the issued policies as taught by Chapman. The Examiner respectfully submits that the Chapman reference teaches a file that includes data relating to a particular insurance policy or the insured, and also similar data stored on a computer in a computer database or other computer file (see: column 3, lines 17-21). In addition, Chapman teaches database (128, Fig. 1) and database (132, Fig. 1) (see: column 3, lines 65 to column 4, lines 14), and it is the Examiner's position that the files, which are stored in databases, include completed insurance application forms since renewal and cancellation forms are generated from completed insurance applications that produce insurance policies.

(C) In response to Applicants arguments that (2) there is no disclosure or suggestion in Chapman that the central computer formats forms and provides completed forms to another part of the system. The Examiner respectfully submits that the broadest interpretation of the recitation "a formatting computer receiving individual client data and formatting forms..." is equivalent to Chapman's cancellation form which are sent to a remote computer terminal (146, Fig. 1) at the insurance carrier office for viewing or printing (see: column 4, lines 21-22). In the broadest sense, a remote computer that receives cancellation notices, which include formatted client data as described by Chapman would read on the claim. Moreover, it unclear as to whether the formatting computer is merely receives data and forms or is formatting the received data into forms and it is also noted that the Applicant's specification does not impart a specific definition to claim language, namely "a formatting computer". Furthermore, Chapman clearly shows that a remote computer receives cancellation notices including client data that is formatted.

(D) In response to Applicants arguments that (3) No motivation has been established for combining the features from Harvey and Chapman; and (5) there is no motivation to introduce

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them into Chapman's system because they are inappropriate for Chapman's purpose. The Examiner respectfully submits that establishing a *prima facie* case of obviousness is determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Hedges*, 783 F.2d 1038, 1039, 228 USPQ 685,686 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785,788 (Fed. Cir. 1984); and *In re Rinehart*, 531 F.2d 1048, 1052, 189 USPQ 143,147 (CCPA 1976). Using this standard, the Examiner respectfully submits that he has at least satisfied the burden of presenting a *prima facie* case of obviousness, since he has presented evidence of corresponding claim elements in the prior art and has expressly articulated the combinations and the motivations for combinations that fairly suggest Applicant's claimed invention (see: paper dated 10/5/05).

In addition, the Examiner recognizes obviousness is not determined by what the references expressly state but by what they would reasonably suggest to one of ordinary skill in the art, as supported by decisions in *In re DeLisle* 406 Fed 1326, 160 USPQ 806; *In re Kell, Terry and Davies* 208 USPQ 871; and *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988) (citing *In re Lalu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)). Further, it was determined in *In re Lamberti et al*, 192 USPQ 278 (CCPA) that:

- (i) obviousness does not require absolute predictability;
- (ii) non-preferred embodiments of prior art must also be considered; and
- (iii) the question is not express teaching of references, but what they would suggest.

Additionally, the Examiner recognizes that references cannot be arbitrarily altered or modified and that there must be some reason why one skilled in the art would be motivated to make the proposed modifications. However, although the Examiner agrees that the motivation

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or suggestion to make modifications must be articulated, it is respectfully contended that there is no requirement that the motivation to make modifications must be expressly articulated within the references themselves. References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures, *In re Bozek*, 163 USPQ 545 (CCPA 1969).

As such, it is respectfully submitted that an explanation based on logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness has been adequately provided by the motivations and reasons indicated by the Examiner in the prior Office Action (see: paper dated 10/5/05), *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter., 4/22/93).

Furthermore, the motivation to combined the teachings of the Harvey within the Chapman reference is given in section 4 of the above Office Action as suggested from a passage in the Harvey column 3, lines 19-22, “providing a system that offers seamless delivery of real-time data from acquisition sites to delivery sites with an integration of all data streams”.

(E) In response to Applicants arguments that (6) there is no suggestion in Chapman of storing “new business information”. The Examiner respectfully submits that the Chapman reference teaches a file that includes data relating to a particular insurance policy or the insured, and also similar data stored on a computer in a computer database or other computer file (see: column 3, lines 17-21). In addition, Chapman teaches database (128, Fig. 1) and database (132, Fig. 1) and cancellation and renewal forms which are sent to a remote computer terminal (146, Fig. 1) at the insurance carrier office for viewing or printing (see: column 3, lines 65 to column 4, lines 14 and column 4, lines 21-37). This suggests that a file includes insurance policies information used for cancellations or renewals and the Examiner considers a possible renewal to

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include new business information because the client's information may be modified or changed to include new business information in the broadest sense.

(E) In response to Applicants arguments that (7) the examiner does not teach or suggest, "image generation means...generating images of insurance policy forms" as required by claim 7. The Examiner respectfully submits that the Chapman et al. references teaches a remote computer terminals (104, Fig. 1) at the insurance agent's location that is connected by secure private network (106, Fig. 1) to the central computer (124, Fig. 1) in the form of a Citrix™ Winframe Enterprise Server (see: column 3, lines 56-62). In addition, Chapman teaches a database (128, Fig. 1) and database (132, Fig. 1) that includes producing cancellations and renewal forms which are sent to a remote computer terminal (146, Fig. 1) at the insurance carrier office for viewing or printing (see: column 3, lines 65 to column 4, lines 14). This clearly shows a remote computer terminal uses received client information from a database and generates image for viewing or printing.

(G) In response to Applicants arguments that (8) there is no disclosure or suggestion in Harvey of "compressed file below a selected size being e-mailed over said e-mail server to a registered agent, said compressed file being included with said e-mail and, compressed files exceeding said selected size being stored on said FTP server" as required by claim 8; and (9) there is no disclosure or suggestion in Chapman of compressed image file of insurance policy forms being stored on said forms database and provided to said data transfer server "wherein said insurance policy forms include insurance policy application, contact forms and contract data" as required by claims 9 and 10. The Examiner respectfully submits the Harvey reference teaches a notification application server (123, Fig. 9B) used to send e-mail messages, with optional

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attachments (see: column 19, lines 31-32, column 20, lines 61-64 and column 15, lines 55-62). In addition, Harvey et al. teaches a FTP application server (122, Fig. 9B) that sends files to an external server using FTP protocol (see: column 19, lines 29-31). Furthermore, Harvey et al. teaches a data compression module for compressing data transmitted over the first, second and third communications network (see: column 7, lines 35-37). This indicates that the notification server uses e-mail to send messages over a network, which is compressed by the compression module. Furthermore, the e-mail messages that have optional attachments may be transmitted according to the size of the file suggesting that a compressed file exceeding a certain size is cannot be transmitted but stored in the FTP application server.

With regard to the insurance policy forms including insurance policy application with contact forms and contract data, it is respectfully submitted that the Chapman et al. teaches an insurance policy forms include insurance policy application and contact forms (see: Fig. 9 and 10, especially name and address or agency or Office issuing). The Examiner considers the renewal policy illustrated in Fig. 10 including a name, date, SSN, etc... to be contract data since this information is necessary to identify an individual involve with a contract.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period


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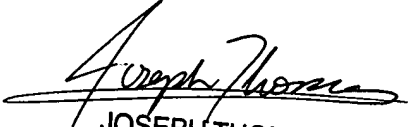
will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert W. Morgan whose telephone number is (571) 272-6773. The examiner can normally be reached on 8:30 a.m. - 5:00 p.m. Mon - Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571) 272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Robert Morgan  
Patent Examiner  
Art Unit 3626

  
JOSEPH THOMAS  
SUPERVISORY PATENT EXAMINER